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Joanna L. Kneller
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of
Sangki Rhee, *et al.*

Serial No. 09/993,192

Filed: November 14, 2001

For: **HANSENULA POLYMORPHA MUTANTS
AND PROCESS FOR PREPARATION OF
RECOMBINANT PROTEINS USING THE SAME**

Group Art Unit: 1636

Examiner: Lambertson, David A.

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

SIR:

ELECTION OF GROUP VII CLAIM - IN RESPONSE TO RESTRICTION

In response to the Office Action dated April 17, 2003, the Applicants herein provisionally elect to prosecute the Group VII claim (i.e., claim 17) as set forth by the Examiner, with traverse.

The Examiner is respectfully reminded that the above-identified application is a *divisional* application, filed November 14, 2001 with a preliminary amendment canceling claims 1-16 and 21-43, leaving only claims 17-20 pending.¹ Accordingly the only claims now pending encompass the following groups set forth by the examiner:

¹ The application is a divisional application of 09/674,617, filed January 3, 2001.

VII. Claim 17, drawn to the *H. polymorpha KEX1* gene.

VIII. Claims 18-19, drawn to a deletion construct for the *KEX1* gene, and cells made with the deletion construct.

IX. Claim 20, drawn to a method for making a protein in a *KEX1* deletion strain.

The Applicants respectfully request the Examiner to combine Groups VII - IX and examine claims 17-20 together. In fact, the subject matter of claims 17-19 is the *KEX1* gene. Accordingly, a single search is required to evaluate the novelty of the subject matter of claims 17-20. The Applicants, accordingly, respectfully submit that a "serious burden" does not exist on the Examiner to examine claims 17-20 together.² **Claim 20 is moreover a product by process claim which relates to the subject matter of claim 19.** The examiner is also respectfully referred to § 803.04 of the Manual of Patent Examining Procedure (MPEP) Edition 8, August, 2001:

803.04 Restriction - Nucleotide Sequences

By statute, "[i]f two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions." **35 U.S.C. 121**. Pursuant to this statute, the rules provide that "[i]f two or more independent and distinct inventions are claimed in a single application, the examiner in his action shall require the applicant . . . to elect that invention to which his claim shall be restricted." **37 CFR 1.142(a)**. See also **37 CFR 1.141(a)**.

Nucleotide sequences encoding different proteins are structurally distinct chemical compounds and are unrelated to one another. These sequences are thus deemed to normally constitute independent and distinct inventions within the meaning of **35 U.S.C. 121**. Absent evidence to the contrary, each such nucleotide sequence is presumed to represent an independent and distinct invention, subject to a restriction requirement pursuant to **35 U.S.C. 121** and **37 CFR 1.141 et seq.** Nevertheless, to further aid the biotechnology industry in

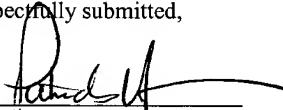
² Criteria for restriction between patentably distinct inventions. MPEP, Edition 8, August, 2001 § 803(B).

protecting its intellectual property without creating an undue burden on the Office, the Commissioner has decided *sua sponte* to partially waive the requirements of **37 CFR 1.141** *et seq.* and permit a reasonable number of such nucleotide sequences to be claimed in a single application. See *Examination of Patent Applications Containing Nucleotide Sequences*, 1192 O.G. 68 (November 19, 1996).

The Applicants respectfully request the Examiner to examine claims 17-20 together. The Examiner is also encouraged to telephone the undersigned in order to expedite any detail of the prosecution.

The Commissioner is authorized to charge any deficiency or credit any overpayment to Deposit Account No. 13-2165.

Respectfully submitted,



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Date: May 15, 2003

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